APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/848,809	05/19/2004	Steven C. Black	15854.3.1	6228

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EXAMINER
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ART UNIT	PAPER NUMBER
3629	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
	10/848,809	BLACK ET AL.
Office Action Summary	Examiner	Art Unit	
	Shaun Sensenig	3629	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☐ Claim(s) *1-11,15-18,29,30 and 32-35* is/are pending in the application.

    4a) Of the above claim(s) *none* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-11,15-18,29,30 and 32-35* is/are rejected.

7) ☒ Claim(s) *35* is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   **Office Action Summary**   Part of Paper No./Mail Date 20090627

DETAILED ACTION

This action is in response to papers filed on March 19, 2009.

Claims 1, 11, and 15 have been amended.

Claims 19-22 and 31 have been cancelled.

Claim 35 has been added.

Claims 1-11, 15-18, 29, 30, and 32-35 are pending.

Claim Objections

1.   **Claim 35** is objected to under 37 CFR 1.75(c), as being of improper dependent
form for failing to further limit the subject matter of a previous claim. Applicant is
required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper
dependent form, or rewrite the claim(s) in independent form. Claim 35 cites material
regarding the order of forms being presented based on changes in legal criteria, which
is also found in Claim 1. No new limitations are present in Claim 35.

Claim Rejections - 35 USC § 101

2.   **Claim1-10 and 29-30 and 32-35** are rejected under 35 U.S.C. 101 based on
Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to
examiners is that a § 101 process must entail the use of a specific machine or
transformation of an article which must impose meaningful limits on the claim's scope to
impart patent-eligibility. *See* Gottschalk v. Benson, 409 U.S. 63, 71-72 (1972). Second,
the involvement of the machine or transformation in the claimed process must not

merely be insignificant extra-solution activity. *See* Parker v. Flook, 437 U.S. 584, 590

(1978). The "client-server environment", as presented in claim 1, performs the

insignificant extra-solution activity of generating without performing any processing

activities. Moreover, while the claimed process contains physical steps (generating,

making, updating), it does not involve transforming an article into a different state or

thing. Therefore, Applicants' claim is not drawn to patent-eligible subject matter under §

101.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

    1.   Determining the scope and contents of the prior art.
    2.   Ascertaining the differences between the prior art and the claims at issue.
    3.   Resolving the level of ordinary skill in the pertinent art.
    4.   Considering objective evidence present in the application indicating
            obviousness or nonobviousness.

5.   Claims 1-11, 29-30, 32, 33, and 35 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Exall et al. (Patent No. US 7,330, 817 B1) (hereafter

referred to as Exall) in view of Peace Corps Applicant Toolkit (hereafter referred

to as PC).

6.   In regards to **Claims 1, 11, and 35,** Exall discloses:

In a client-server environment, a method for facilitating the management of human

resources compliance efforts, the method comprising:

        generating a plurality of human resources compliance forms that substantially

conform to predetermined legal criteria; (Column 4, lines 54-67 and Column 5, lines 1-

7, *shows the creation of forms in relation to predetermined legal criteria*)

        updating, as required, at least one of the plurality of human resources

compliance forms to conform with a change in the legal criteria; (Column 5, lines 1-7,

shows updates based on changes in legal criteria)

        making the updated human resources compliance form available to the client.

(Column 4, lines 54-67 and Column 5, lines 1-7, *shows forms being updated while*

currently available to the client)

        Exall discloses making the plurality of human resources compliance forms

available to a client (Column 4, lines 54-67 and Column 5, lines 1-7, *shows forms being*

available to the client) and legal criteria data corresponding to the client; (Column 5,

lines 1-7, *shows legal data relating to the client*). Exall does not explicitly disclose

activities performed in a specific order based on status and legal requirements, however

PC teaches activities performed in a specific order based on status and legal

requirements. (Pages 4-9, *steps 3 and 5-9 show steps being done in a specific order in*

which each step must be completed before the next one is started based on status and

legal requirements)

It would have been obvious to one of ordinary skill in the art, at the time of the

invention, to have modified the system of Exall so as to have included the activities

performed in a specific order based on status and legal requirements taught by PC in

order to ensure efficiency and reliability by not allowing the client to perform activities in

an order that is well-known to be legally non-compliant or to perform activities in an

order that is considered to be procedurally inefficient or unnecessary, since doing so

could be performed readily and easily by any person of ordinary skill in the art, with

neither undue experimentation, nor risk of unexpected results.

Neither Exall not PC explicitly disclose determining whether the change in the

legal criteria requires a corresponding change in the order in which a form is presented

to the client and presenting the forms in that order, however, it would have been

obvious to one of ordinary skill in the art, at the time of the invention, to have further

modified the system of Exall so as to have included determining whether the change in

the legal criteria requires a corresponding change in the order in which a form is

presented to the client and presenting the forms in that order (See KSR [127 S Ct. at

1739] "The combination of familiar elements according to known methods is likely to be

obvious when it does no more than yield predictable results.") in order to ensure

efficiency and reliability by not allowing the client to perform activities in an order that is

legally non-compliant or to perform activities in an order that is considered to be

procedurally inefficient or unnecessary, since doing so could be performed readily and

easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

7.   In regards to **Claim 2**, Exall discloses wherein forms related to the screening of applicants and the hiring of employees are made available (Abstract, lines 2-3; Column 4, lines 54-67; and Column 5, lines 1-7), but Exall does not disclose the specific forms that are provided (a first rejection letter form, a second rejection letter form, a conditional acceptance letter form, a drug screening authorization form, background screening authorization form, a third rejection letter form, an intent-not-to-hire letter form, and a new hire document). However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have included these or similar forms as available resources since the actions they represent are common among human resource functions.

8.   In regards to **Claim 3**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the predetermined legal criteria and human resources compliance forms correspond to employee hiring. (Column 16, lines 34-46)

9.   In regards to **Claim 4**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the predetermined legal criteria and human resources compliance forms correspond to employee termination. (Column 20, line 1)

10.   In regards to **Claim 5**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the predetermined legal criteria and human resources compliance forms correspond to employee training. (Column 4, lines 12-16)

11.   In regards to **Claim 6**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the predetermined legal criteria and human resources compliance forms correspond to employee compensation. (Column 2, lines 60-63 and Column 22, lines 23-24)

12.   In regards to **Claim 7**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the status data corresponds to at least one of a client characteristic and an employee of the client. (Column 9, lines 7-21)

13.   In regards to **Claim 8**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein generating the human resources compliance forms includes receiving the status data from the client. (Column 9, lines 7-21)

14.   In regards to **Claim 9**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the status data is received from a third party. (Column 9, lines 7-21)

15.   In regards to **Claim 10**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the status data is received from a third party resource. (Column 9, lines 7-21)

16.   In regards to **Claim 29**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein updating, as required, at least one of the plurality of human resources compliance forms to conform with a change in the legal criteria comprises dynamically updating, in automatic response to a determination that a change in a law has occurred, at least one of the plurality of human resources compliance forms to accommodate the change in the law. (Column 4, lines 54-67 and Column 5, lines 1-7)

17.   In regards to **Claim 30**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein updating, as required, at least one of the plurality of human resources compliance forms to conform with a change in the legal criteria comprises: automatically determining that the change in a law created a conflict with an existing one of the plurality of human resources compliance forms; and automatically updating the existing human resources compliance form to accommodate the change in the law. (Column 4, lines 54-67 and Column 5, lines 1-7)

18.   In regards to **Claim 32**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, further comprising: generating a notice regarding

the change in the legal criteria; and making the notice available to the client. (Column 9, lines 21-40)

19.   In regards to **Claim 33**, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the notice advises the client of the change in the legal criteria and instructs the client of the steps that should be taken to remain compliant with the change in the legal criteria. (Column 9, lines 21-40)

20.   **Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Exall in view of PC in further view of Warady et al. (Patent Number 6,067,522) (hereafter referred to as Warady).**

21.   In regards to **Claim 15**, Exall discloses:

In a client-server environment, a user interface provided by a server for facilitating the management of human resources compliance efforts, the user interface comprising:

an interface configured to provide a client access to a plurality of forms for use in a human resources process, wherein client access to the forms is controlled at least in part by legal criteria governing the human resources process, and wherein at least one of the forms is dynamically updated by the server to reflect changes in the legal criteria; (Column 4, lines 54-67 and Column 5, lines 1-7, *shows forms in relation to predetermined legal criteria, shows forms being available to the client, and shows updates based on changes in legal criteria* and Column 6, lines 62-63, *shows an interface used to interact with the system*)

an interface configured to reflect changes in the legal criteria; (Column 4, lines

16-20, *shows capabilities to monitor legal criteria changes,* and Column 6, lines 62-63,

shows an interface used to interact with the system) and

Exall does not explicitly disclose materials available in a specific order based on

status and legal requirements, however PC teaches materials available in a specific

order based on status and legal requirements. (Pages 4-9, *steps 3 and 5-9 show steps

being done in a specific order in which each step must be completed before the next

one is started based on status and legal requirements*)

It would have been obvious to one of ordinary skill in the art, at the time of the

invention, to have modified the system of Exall so as to have included the materials

available in a specific order based on status and legal requirements taught by PC in

order to ensure efficiency and reliability by not allowing the client to perform activities in

an order that is well-known to be legally non-compliant or to perform activities in an

order that is considered to be procedurally inefficient or unnecessary, since doing so

could be performed readily and easily by any person of ordinary skill in the art, with

neither undue experimentation, nor risk of unexpected results.

Neither Exall not PC explicitly disclose updating the order in which forms are

based on changes in legal criteria, however, it would have been obvious to one of

ordinary skill in the art, at the time of the invention, to have further modified the system

of Exall so as to have included updating the order in which forms are based on changes

in legal criteria in the order in which a form is presented to the client and presenting the

forms in that order (See KSR [127 S Ct. at 1739] "The combination of familiar elements

according to known methods is likely to be obvious when it does no more than yield

predictable results.") in order to ensure efficiency and reliability by not allowing the client

to perform activities in an order that is legally non-compliant or to perform activities in

an order that is considered to be procedurally inefficient or unnecessary, since doing so

could be performed readily and easily by any person of ordinary skill in the art, with

neither undue experimentation, nor risk of unexpected results.

Neither Exall nor PC explicitly disclose an interface configured to reflect status

data of employees working for the client including form customization for the employee,

however Warady teaches:

an interface configured to reflect status data of employees working for the client,

the at least one updated form being customized for at least one of the employees based

on the status of the at least one employee. (Column 1, lines 45-46, *shows*

customization of forms for employees; Column 5, lines 12-13, *shows employee files*

containing status information; Column 8, lines 27-31, *shows an interface to manage*

employee files; and Column 9, lines 47-58, *shows employee data being updated by an*

external entity)

It would have been obvious to one of ordinary skill in the art, at the time of the

invention, to have further modified the system of Exall so as to have included an

interface configured to reflect status data of employees working for the client including

form customization for the employee taught by Warady in order to increase efficiency

and usability by allowing users to monitor progression and by tailoring materials to the

users specific needs, since doing so could be performed readily and easily by any

person of ordinary skill in the art, with neither undue experimentation, nor risk of
unexpected results.

Examiner's Note: Examiner points out that the prior art pertains to an interface
capable of showing multiple types of information and/or separate interfaces intended for
different types of information, however, these would be equivalent to an interface
containing three portions due to the fact that they present equivalent information
differing only by visual format .

22.   In regards to **Claim 16**, Neither Exall nor PC explicitly disclose the ability of a
client to modify data used to auto-populate forms, however it would have been obvious
to one of ordinary skill in the art, at the time of the invention, to have further modified the
system of Exall so as to have included the ability of a client to modify data used to auto-
populate forms in order to reduce errors and any resulting problems by retaining the
ability to correct any errors, since doing so could be performed readily and easily by any
person of ordinary skill in the art, with neither undue experimentation, nor risk of
unexpected results.

23.   In regards to **Claim 17**, Exall discloses:

In a client-server environment, a user interface provided by a server for
facilitating the management of human resources compliance efforts, wherein the forms
are customized according to client characteristics. (Column 2, lines 25-27)

24.   In regards to **Claim 18**, Exall discloses:

In a client-server environment, a user interface provided by a server for
facilitating the management of human resources compliance efforts, further including an

interface portion configured to display training materials and to track training progress.

(Column 4, lines 12-16; Column 5, lines 10-12; and Column 12, lines 40-42)

25.   Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Exall in view of PC in further view of Jinks (Pub. No. US 2002/0055862 A1).

In regards to **Claim 34**, Exall discloses: making the at least one updated form

available to the client. (Column 4, lines 54-67 and Column 5, lines 1-7t)

Neither Exall nor PC explicitly disclose auto-populating the forms with data,

however Jinks teaches auto-populating the forms with data; ([0035], line 12)

It would have been obvious to one of ordinary skill in the art, at the time of the

invention, to have further modified the system of Exall so as to have included auto-

populating the forms with data as taught by PC in order to increase usability and

efficiency by reducing redundant work, since doing so could be performed readily and

easily by any person of ordinary skill in the art, with neither undue experimentation, nor

risk of unexpected results.

Response to Arguments

1.   Applicant's arguments filed March 19, 2009 have been fully considered but they

are not persuasive.

2.   I. Rejection of Claims under 35 U.S.C. §101

Applicant argues that the 101 rejection was improperly applied because the

claims transform data representing an underlying physical object. As the claim is

written, it could be performed using a paper and pencil and does not require a machine

(nor is one claimed). However, if it were using a machine, as Applicant appears to believe according to the arguments, it would not matter, because the generated forms would not represent an underlying physical object (for example, "structure of bones, organs, and other body tissues" *from Applicant cited section(s) of Bilski*). The generated forms could only represent the *data* that would appear on a physical document. Also, the generating of forms would be done by/with the machine and the data representing the generated form would not necessarily represent any underlying physical object (the fact that an equivalent physical object exists somewhere does not tie the electronic version to it). Also, the simple adding or removing of data does not represent a transformation since no significant processing activities are performed. For those reasons, the claims do not represent patent-eligible subject matter under the transformation requirement.

3.   II. Rejection of Claims under 35 U.S.C. §103

Applicant 's arguments in regards to the 35 U.S.C. §103 rejections are moot in view of the new prior art rejections.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Shaun Sensenig whose telephone number is (571) 270-

5393. The examiner can normally be reached on Monday to Thursday 7:30 to 5:00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Weiss can be reached on (571)272-6812. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. S./
Examiner, Art Unit 3629
June 28, 2009

/JOHN G. WEISS/
Supervisory Patent Examiner, Art Unit 3629